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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/844,475 | 04/27/2001 | James C. Hillegass | 2160 | 9128 |

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| EXAMINER | |
|---|---|
| CHEUNG, MARY DA ZHI WANG | |
| **ART UNIT** | **PAPER NUMBER** |
| 3621 | |

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/844,475 | HILLEGASS ET AL. | |
| | Examiner | Art Unit | |
| | Mary Cheung | 3621 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *24 June 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-40* is/are pending in the application.

4a) Of the above claim(s) *15-40* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *3/29/2002*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Status of the Claims*

1. This action is in response to the election of the restricted claims filed on June 24, 2004. Claims 1-40 are pending. Claims 1-14 are elected without traverse. Claims 15-40 are non-elected group, thus they are withdrawn from consideration.

### *Claim Rejections - 35 USC § 101*

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claims 1-11 only recite an abstract idea. The recited steps merely disclose obtaining identification information from different sources, and then making comparisons to determine if the

user is licensed to access the digital content. These steps do not apply, involve, use, or advance the technological arts since all of the **recited steps can be performed in the mind of the user or by use of a pencil and paper**. These steps only constitute an idea of how to determine if a user is licensed to access digital content over another.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention verifies if a user is licensed to access digital content (i.e. useful, concrete, and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above are deemed to be directed to non-statutory subject matter. Applicant is advised to include computer-implemented steps in the claims in order to overcome the rejections, such as "electronically obtaining a product from the content files", "electronically comparing the product ID", etc.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Colosso, U. S. Patent 6,169,976.

As to claim 1, Colosso teaches a method for verifying that a user is licensed to access digital content within a content file comprising (abstract):

a) obtaining a product ID from the content file (column 11 lines 58-67 and Fig. 3; *specifically, "product ID" corresponds to the serial number, and "content file" corresponds to database 314 of Fig. 3 in Colosso's teaching*);

b) comparing the product ID from the content file with a second product ID found in a product license (column 11 lines 58-67 and column 13 lines 54-59 and column 14 lines 15-30);

c) obtaining a user ID from the product license (column 13 lines 15-19);

d) comparing the user ID from the product license with a second user ID found in a user license (column 13 lines 20-48).

As to claim 2, Colosso teaches wherein the user license further contains personal information that is accessible to the user, such that the user would be reluctant to share the user license with other users (column 10 lines 15-21 and column 13 lines 7-40).

As to claim 12, the steps a) through d) are rejected for the similar reasons as claims 1 as above. Further more, Colosso teaches e) accessing the appropriate product license to determine a decryption key associated with the product license; and f) decrypting the encrypted digital content using the decryption key (column 14 line 56 – column 15 line 60).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colosso, U. S. Patent 6,169,976 in view of Murko, Jr., U. S. Patent 6,578,014.

As to claims 3-5, Colosso teaches wherein the user license further contains personal information as discussed above. Colosso does not specifically teach that the personal information a financial access number. However, Murko teaches user has access of personal information that comprising financial access numbers (Fig. 7b). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the personal information in Colosso's teaching to include financial access

numbers as taught by Murko because this would accelerate process of royalty payment to the seller of the digital content.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Colosso, U. S. Patent 6,169,976 in view of Misra et al., U. S. Patent 6,189,146.

As to claim 6, Colosso teaches verifying a user to access a licensed digital content as discussed in claim 1 above. Colosso does not specifically teach obtaining identifying system information from the user license, and comparing the identifying system information from the user license with identifying information obtained from a computer operating system being used by the user to access the digital content. However, Misra teaches obtaining system ID from the user's computer and identifying information regarding said user's license, and compare the system ID with the identifying information regarding the user's license (column 12 lines 40-55 and column 16 lines 44-67 and Figs. 3, 8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Colosso's teaching to include the feature of comparing the user's system ID with the identifying information of the user's license for preventing unauthorized access of the digital content.

10. Claims 7-11 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colosso, U. S. Patent 6,169,976 in view of Schneck et al., U. S. Patent 5,933,498.

As to claims 7-9, Colosso teaches the appropriate license level of the licensed digital content is enforced based on key information (abstract and Fig. 5). Colosso does not specifically teach allowing access to a first portion of the digital content when the comparisons of step b) and d) both result in successful comparisons; allowing access to

a second portion of the digital content when either of the comparisons of step b) and d) are not successful; and wherein the first portion of the digital content is encrypted and the second portion of the digital content is not encrypted. Schneck teaches the digital content comprises encrypted portion and unencrypted portion (Fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the digital content in Colosso's teaching to include encrypted and unencrypted portion for better defining license level. Furthermore, it would have been obvious to one of ordinary skill in the art to allow the teaching of Colosso modified by Schneck to include the feature of allowing access of the encrypted portion of the digital content if the comparisons of step b) and d) is successful, and allowing access of the unencrypted portion of the digital content if neither of the comparison is successful for better defining license level of the digital content and providing user with variety levels of access to digital content.

As to claim 10, Colosso teaches wherein the first portion of the digital content is encrypted using a product encryption key (column 14 line 56 – column 15 line 60).

As to claim 11, Colosso teaches wherein the product encryption key is found in the product license (column 14 line 56 – column 15 line 60).

As to claim 13, Colosso teaches the appropriate license level of the licensed digital content is enforced based on key information, and decrypting the encrypted data (abstract and column 15 line 45-60 and Fig. 5). Colosso does not specifically teach non-encrypted data is found in the content file containing the encrypted digital content, and wherein the non-encrypted data is accessible when the appropriate product license

or the appropriate user license is not found. However, Schneck teaches the encrypted digital content comprises unencrypted portion (Fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the digital content in Colosso's teaching to include unencrypted portion of the digital content for better defining license level. Furthermore, it would have been obvious to one of ordinary skill in the art to allow the teaching of Colosso modified by Schneck to include the feature of allowing access of the unencrypted portion of the digital content when the appropriate product license or the appropriate user license is not found for better defining license level of the digital content and providing user with variety levels of access to digital content.

As to claim 14, Colosso modified by Schneck teaches allowing access to the non-encrypted data when the appropriate product license or the appropriate user license is not found as discussed in claim 13 above. Colosso does not specifically teach wherein an option to purchase full access rights to the encrypted digital data is presented to the user when the appropriate product license or the appropriate user license is not found. Schneck further teaches selling various levels of access rights to the user of the digital content (column 22 lines 55-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Colosso modified by Schneck further include the feature of an option for the user of the digital content to purchase various levels of access rights, thus to better defining license level of the digital content and providing user with variety levels of access to digital content.

***Conclusion***

11. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shkedy (U. S. Patent 6,260,024) discloses buyer-driven purchase order on a commercial network system.

Schoch et al. (U. S. Patent 6,460,140) discloses controlling use of licensed software.

Hatakeyama (JP 2003178164 A) discloses providing flexible contents utilization control and accurate prevention of fraudulent utilization of contents to an information provision authority.

**Inquire**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Plaza Two, Room 1B03.

Mary Cheung
Patent Examiner
Art Unit 3621
September 24, 2004